

Notice of Allowability

Application No.

10/713,490

Examiner

Peter J. Vrettakos

Applicant(s)

MCGAFFIGAN ET AL.

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to App filed 11-14-03.
2. ☒ The allowed claim(s) is/are 21-35.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>12-14-05</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: claims 1-20 are toward an electrosurgical surgical device.

Species II: claims 21-35 are towards electrosurgical tweezers.

Species III: claims 36-50 are towards electrosurgical forceps.

Species IV: claims 51-64 are towards electrosurgical graspers.

Species V: claims 65-106 are towards a divide and seal device.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with David Crockett on 10-14-05 a provisional election was made without traverse to prosecute the invention of electrosurgical tweezers (species II), claims 21-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20 and 36-106 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with David Crockett on 10-14-05.

The application has been amended as follows:

1. Claim 21, line 19: -- being also electrically insulative -- has been inserted after "plate".
2. Claim 22, line 1: "9" has been deleted.
3. Claim 22, line 1: --21-- has been inserted after "claim".
4. Claim 27, line 2: "conductivity" has been deleted.
5. Claim 27, line 2: -- conductive-- has been inserted after "thermally".

The following is an examiner's statement of reasons for allowance:

Non-elected (without traverse) claims 1-20 and 36-106 are cancelled. Elected claims 21-35 are pending. Claim 21 is the lone independent.

The prior art neglects to disclose tweezers with two grasping arms, a resistive heating element each covered with resilient material and a ***thermally conductive and electrically insulative plate*** as found in the applicant's independent claim 21, described in the specification page 3:16-19, *inter alia*, and depicted in figures 5 and 6 element 39. The application discloses that the plate's purpose is to improve heat generation in the targeted tissue (while preventing the flow of electricity into the body, which is well known in the related art to potentially have unforeseen harmful effects at remote (areas other than that targeted) tissue regions).

The Office has searched the prior art for a plate of similar characteristics (conductive and insulative) in an analogous device (tweezer/grasper with a heating element). Several patents were unearthed. The Treat patent (6,626,901) depicts in figure 16, tweezers (col. 9:58-61) with grasping arms (224) each covered with resilient material (231), and a resistive heating element (228). The patent *neglects* to disclose a thermally conductive and electrically **insulative** plate. Next, see McMullen (5,704,377) plate element number 58. Although the patented plate is structurally analogous to the Applicant's plate, McMullen makes no mention of the plate being electrically insulative. Instead, the plate is described as thermally conductive (and implicitly as electrically conductive). To this end, the patented plate cannot be fairly combined with the Treat patent in an obviousness rejection of claim 21.

Eggers et al. (5,891,142) and Truckai et al. (6,929,644) both disclose thermally tweezers with tips made of materials that display thermal conductivity and electrical insulation. Eggers in figure 11 depicts a thermally conductive element 112 (copper) and

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an electrically insulative spacer element 124 (alumina). It cannot be said, however, that Eggers discloses or suggests a thermally conductive and electrically insulative plate. Further, Truckai discloses in an alternate embodiment in col. 16:1-4 the idea of a thermally conductive but electrically insulative layer between a resistance material and a conductive layer all in forceps. However, this description is vague and cannot fairly be used as part of an obviousness rejection against the Applicant's plate.

It should also be noted that materials being both thermally **conductive** and electrically **insulative** is at first glance, counterintuitive. Typically, a material is either both thermally and electrically conductive (ex. metals) or both insulative (ex. dielectrics). This is seen in Truckai col. 5:11-14. These typical material characteristics (ex. both conductive) in the claim would most likely meet an obviousness rejection with Treat as the main reference and a secondary reference teaching a plate exhibiting thermally and electrically conducting properties, such as McMullen (5,704,377). However, the rarer and less obvious instance has a material displaying thermally **conductive** and electrically **insulative** properties, such as that disclosed in claim 21. These facts further make claim 21 allowable (because the claimed plate is thermally conductive and electrically insulative).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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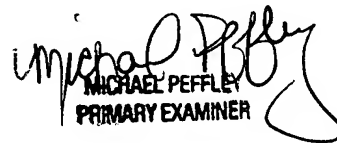
accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
October 15, 2005



MICHAEL PEFLEY
PRIMARY EXAMINER